

06-14-04

PATENT APPLICATION *IFW*

ATTORNEY DOCKET NO. 200208752-1

IN THE  
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Benjamin J. Patella et al.

Confirmation No.: 8246

Application No.: 10/614,309

Examiner: M. T. Nguyen

Filing Date: 07-07-2003

Group Art Unit: 2816

Title: SYSTEM AND METHOD FOR EVALUATING THE SPEED OF A CIRCUIT

Mail Stop Amendment  
Commissioner for Patents  
PO Box 1450  
Alexandria, VA 22313-1450

TRANSMITTAL LETTER FOR RESPONSE/AMENDMENT

Sir:

Transmitted herewith is/are the following in the above-identified application:

- |   |   |
|---|---|
| <input type="checkbox"/> Response/Amendment   | <input type="checkbox"/> Petition to extend time to respond |
| <input type="checkbox"/> New fee as calculated below                                  | <input type="checkbox"/> Supplemental Declaration           |
| <input checked="" type="checkbox"/> No additional fee                                 |   |
| <input checked="" type="checkbox"/> Other: <u>Election to Restriction Requirement</u> | (fee \$ <u>                    </u> )                       |

CLAIMS AS AMENDED BY OTHER THAN A SMALL ENTITY						
(1) FOR	(2) CLAIMS REMAINING AFTER AMENDMENT	(3) NUMBER EXTRA	(4) HIGHEST NUMBER PREVIOUSLY PAID FOR	(5) PRESENT EXTRA	(6) RATE	(7) ADDITIONAL FEES
TOTAL CLAIMS		MINUS		= 0	X \$18	\$ 0
INDEP. CLAIMS		MINUS		= 0	X \$86	\$ 0
[ ] FIRST PRESENTATION OF A MULTIPLE DEPENDENT CLAIM					+ \$290	\$ 0
EXTENSION FEE	1ST MONTH \$110.00	2ND MONTH \$420.00	3RD MONTH \$950.00	4TH MONTH \$1480.00		\$ 0
OTHER FEES						\$
TOTAL ADDITIONAL FEE FOR THIS AMENDMENT						\$ 0

Charge \$ 0 to Deposit Account 08-2025. At any time during the pendency of this application, please charge any fees required or credit any overpayment to Deposit Account 08-2025 pursuant to 37 CFR 1.25. Additionally please charge any fees to Deposit Account 08-2025 under 37 CFR 1.16 through 1.21 inclusive, and any other sections in Title 37 of the Code of Federal Regulations that may regulate fees. A duplicate copy of this sheet is enclosed.

"Express Mail" label no. EV482734616US

Date of Deposit 06-11-2004

I hereby certify that this is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated above and is addressed to: Commissioner for Patents, Alexandria, VA 22313-1450.

By

Gail Miller

Typed Name: Gail Miller

Respectfully submitted,

Benjamin J. Patella et al.

By William B. Tiffany

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Attorney/Agent for Applicant(s)

Reg. No. 41,347

Date: 06-10-2004



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Docket No.: 200208752-1  
(PATENT)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Patent Application of:  
Benjamin J. Patella et al.

Confirmation No. 8246

Application No.: 10/614,309

Art Unit: 2816

Filed: July 7, 2003

Examiner: M. T. Nguyen

For: SYSTEM AND METHOD FOR EVALUATING  
THE SPEED OF A CIRCUIT

**RESPONSE TO ELECTION OF SPECIES REQUIREMENT**

MS Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

Responsive to the Election of Species requirement set forth in the Office Action mailed May 12, 2004 (Paper No. 050704) (hereinafter "Election of Species"), Applicants hereby provisionally elect, with TRAVERSE, Species I, comprising claims 1-7, 11-12, and 15-20, for continued examination.

The Examiner has required Election of Species between claims 1 – 5 (collectively Species I), claims 6-14 (collectively Species II), and claims 15-23 (collectively Species III). In support of this requirement, the Examiner has categorized the embodiments described by the claims of respective Species I, Species II, and Species III as distinct and separate species of the claimed invention. Applicants respectfully traverse the Examiner's classification.

The Examiner asserts that Species I claims 1-5 are drawn to a circuit having the structure shown in Applicants' FIGURE 2A, whereas Species II claims 6-14 are drawn to a system and method for evaluating the speed of a circuit having the structure and steps shown in Applicants' FIGURE 5, and Species III claims 15-23 are drawn to a method for evaluating the speed of a circuit having the steps shown in Applicants' FIGURE 6.

Applicants assert that both Species I claims 1-5 and Species II claim subset 11-12 address structural aspects of and thus read on the embodiment depicted in Applicants' FIGURE 2A. Species II claim subset 11-12 addresses these aspects from a high level perspective, whereas Species I claims 1-5 address similar aspects from a lower level perspective. Applicants' FIGURE 2A depicts the structure of both the circuit under evaluation for speed measurement and the system performing the evaluation. Applicants respectfully submit that claims 1-5 and 11-12 should properly be reclassified as Species I claims reading on the embodiment depicted in FIGURE 2A. It is noted that Species II claim subset 13-14 depends from claim 11, which reads on the embodiment depicted in FIGURE 2A and is thus part of Species I.

Similarly, both Species III claims 15-20 and Species II claim subset 6-7 recite a method of using and thus read on the embodiment depicted in Applicants' FIGURE 2A. The methods of using the embodiment of FIGURE 2A are recited from a high level perspective in Species III claims 15-20, whereas methods of using the embodiment of FIGURE 2A are recited from a lower level perspective in Species II claim subset 6-7. Accordingly, Applicants submit that claims 15-20 and claim subset 6-7 should properly be reclassified as Species I claims reading on the embodiment depicted in FIGURE 2A. It is noted that claims 21-23 depend either directly or indirectly from claim 15, which reads on the embodiment depicted in FIGURE 2A and thus is part of Species I. Likewise, claims 8-10 depend from claim 6, which reads on the embodiment depicted in FIGURE 2A and is thus also part of Species I.

In view of the above, Applicants believe that the Examiner's classification of the claims into respective Species I, II, and III is improper, and respectfully request the Examiner to withdraw his classification and Election of Species requirement and to proceed with examination on the merits of Species I claims 1-7, 11-12, and 15-20, reading on the embodiment depicted in FIGURE 2A.

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Applicants believe no fee is due with this response. However, if a fee is due, please charge Deposit Account No. 08-2025, under Order No. 200208752-1, from which the undersigned is authorized to draw.

Dated: June 10, 2004

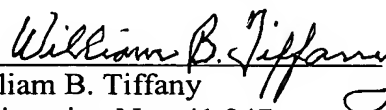
I hereby certify that this correspondence is being deposited with the U.S. Postal Service as Express Mail, Airbill No. EV482734616US, in an envelope addressed to: MS Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date shown below.

Dated: June 11, 2004

Signature:

  
Gail Miller

Respectfully submitted,

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